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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 10/615,972 | 07/09/2003 | Kenneth S. Wales | END907-0511043 | 1293 |
| 7590 06/28/2004 FROST BROWN TODD LLC 2200 PNC Center 201 E. Fifth Street Cincinnati, OH 45202-4182 | | | EXAMINER DURAND, PAUL R | |
| | | | ART UNIT 3721 | PAPER NUMBER |

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/615,972 | Applicant(s) WALES, KENNETH S. | |
| | Examiner Paul Durand | Art Unit 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/03 and 02/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, or the claims or drawings do not adequately convey where the lateral articulation and rotation means are located on the tool and if they replace or are coupled to the articulation means and rotation that are shown in figures 1,2 and 6-8.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,5,6,11,13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milliman et al (US 6,241,139) in view of Bolanos et al (US 5,575,799).

In regard to claims 1,11,13 and 15, Milliman discloses the invention substantially as claimed including a surgical instrument 10, handle 22, shaft 14, which contains the firing, articulation and rotation mechanisms, anvil 20, a firing device, with cutting blade 280, which travels in channel 282, end effector 17, and articulation mechanism 120 comprised of actuation lever 30, which causes articulation of the end effector as it is moved (see Figs. 1,4,9,10 and C9,L22-29). What Milliman does not disclose is the use of a lateral moving member to articulate the end effector. However, Bolanos teaches that it is old and well known in the art of surgical tools to provide an actuation member 113, which when movingly rotated in a lateral direction articulates the end effector 107 for the purpose of allowing the user to efficiently work at different angles (see Figs. 1,2,5 and C5,L30-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Milliman with the articulation means as taught by Bolanos for the purpose of allowing the user to efficiently work at different angles.

In regard to claims 5 and 6, Milliman discloses the invention substantially as claimed except for transferring rotational motion to gears to articulate the end effector. However, Bolanos teaches that it is old and well known in the art of surgical tools to provide a shaft 103, rotary driver 40, which contains rotary joint 104 and bevel gear 36, which converts the rotational motion of the driver into articulation motion for the purpose of adjusting the working angle of a tool (see Figs. 2,3 and C4,L31-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to have provided the invention of Milliman with the articulation means as taught by Bolanos for the purpose of adjusting the working angle of a tool.

Examiner Comment

5. No prior art is currently applied against claims 2-4,7-10,12 and 14 under 35 USC §102 or §103

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Melling et al, Allen et al, Jones et al, Bishop et al, Heck, Green et al, Hamblin et al, Huitema et al, Heaton et al, Tovey et al and Nicholas et al have been cited to show devices having similar structure.

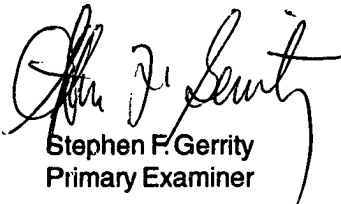
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
June 22, 2004



Stephen F. Gerrity
Primary Examiner